

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT H. JOHNSTON

Appeal No. 2001-2299
Application 08/992,878

ON BRIEF

Before FRANKFORT, MCQUADE, and NASE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Robert H. Johnston appeals from the final rejection of claims 1, 3, 6, 8 and 19, all of the claims pending in the application.

THE INVENTION

The invention relates to a seed envelope having a window covered by a transparent sheet to allow a user to view the seeds prior to purchasing or opening the envelope. A copy of the

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appealed claims appears in the appendix to the appellant's main brief (Paper No. 12).

THE PRIOR ART

The references relied on by the examiner as evidence of obviousness are:

Tullar	1,962,921	Jun. 12, 1934
Berkowitz	2,114,367	Apr. 19, 1938

THE REJECTION

Claims 1, 3, 6, 8 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tullar in view of Berkowitz.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 12 and 14) and to the examiner's answer (Paper No. 13) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

DISCUSSION

Tullar, the examiner's primary reference, discloses an opaque folder D adapted to enclose materials (e.g., letters or checks) mailed in window envelopes "of standard size and shape" (page 1, line 30). The folder functions to prevent unauthorized viewing of the materials through the envelope window. Tullar's description of the envelope, which is shown in Figures 1 and 3 as having the shape and construction of a conventional business

envelope, is relatively brief and lacking in detail, to wit: "A denotes an envelope provided with a window opening B, which may be covered with a transparent sheet C secured to the inside of the envelope" (page 1, lines 99 through 102).

Berkowitz discloses a self-sealing envelope designed to prevent the unintended escape of powder, seeds, or other such merchandise (see page 2, column 1, lines 31 through 38). As shown in Figures 1 and 2, the height of the envelope from top to bottom is greater than its width from side to side.

It is not disputed that each of the foregoing references fails to respond to a number of limitations in independent claims 1 and 9. Nonetheless, the examiner submits (see page 3 in the answer) that their combined teachings would have suggested an envelope having (1) an aperture on its front face covered by a transparent sheet, and (2) a height from top to bottom greater than its width from side to side. As for the various dimensional limitations set forth in claims 1 and 9, the examiner contends (see page 5 in the answer) that such are taught by the combined reference drawings, or would have been an obvious matter of design choice.

Claim 1 requires the seed envelope recited therein to have a height between about 9 cm and about 15 cm and a width between

about 6 cm and about 10 cm, with the height being greater than the width, and an aperture having a width of at least 1 cm which is closer to the bottom edge than to the top edge and spaced between about 1/2 cm and about 2 cm from the bottom edge and between about 1/2 cm and about 8 cm from each of the side edges of the envelope. Claim 19 requires the seed envelope recited therein to comprise an aperture having a width about 80% of the width of the envelope and which is spaced between about 1/2 cm and about 2 cm from the bottom edge and between about 1/2 cm and about 8 cm from each of the first and second side edges of the envelope. As explained in the underlying specification, these parameters permit the envelope to fit on a standard seed envelope display rack, provide it with structural strength sufficient to withstand the seed filling operation and allow the seed to be viewed when the envelope is supported on the display rack.

The examiner's reliance on the Tullar and Berkowitz drawings as teaching various of the foregoing dimensions is not well founded. Patent drawings do not define the precise proportions of the elements shown therein and may not be relied on to show particular sizes if the specification is, as here, completely silent on the issue. Hockerson-Halberstadt Inc. v. Avia Group International Inc., 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed.

Cir. 2000). Moreover, the examiner has not explained, nor is it apparent, why the artisan would have found it obvious to combine the dimensions respectively disclosed by the two references in the manner proposed. Furthermore, given the stated purposes of the various dimensions recited in claims 1 and 19, such cannot be baldly dismissed as obvious matters of design choice.

Hence, the combined teachings of Tullar and Berkowitz do not justify the examiner's conclusion that the differences between the subject matter recited in independent claims 1 and 19 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1 and 19, or of dependent claims 3, 6 and 8, as being unpatentable over Tullar in view of Berkowitz.

REMAND

The application is hereby remanded to the examiner to consider:

a) whether the appellant's specification meets the written description requirement of 35 U.S.C. § 112, first paragraph, with respect to the subject matter now recited in claim 19; and

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b) whether U.K. Patent Application 2,260,531 A (copy appended hereto) provides any basis for an appropriate prior art rejection of the appellant's claims.

With regard to the first point, claim 19 expressly covers a seed envelope comprising an aperture which is spaced between about 1/2 cm and about 8 cm from each of the side edges of the envelope and which has a width being about 80% of the width of the envelope. In other words, and with respect to the upper end of the foregoing range, claim 19 expressly covers an envelope having a width well in excess of the between about 6 cm and about 10 cm width described in the original specification.

As for the second point, the British reference discloses a seed packet or envelope which has a see-through window (see the Abstract; page 4; and claim 9).

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SUMMARY

The decision of the examiner to reject claims 1, 3, 6, 8 and 19 is reversed, and the application is remanded to the examiner for further consideration.

REVERSED AND REMANDED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	APPEALS AND
JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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